

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No.45

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** DAVID B. EDWARDS, WILLIAM J. MCCARTHY,  
ALAN J. ALDRED and ANTHONY D. JACKMAN

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Appeal No. 1997-1235  
Application No. 08/316,717<sup>1</sup>

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ON BRIEF

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Before CALVERT, FRANKFORT, and PATE, **Administrative Patent Judges**.

PATE, **Administrative Patent Judge**.

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<sup>1</sup> Application for patent filed September 30, 1994.  
According to appellants, the application is a continuation of  
Application 07/937,437, filed August 27, 1992, now abandoned;  
which is a continuation of Application 07/845,358, filed March  
5, 1992, now abandoned; which is a continuation of Application  
07/623,995, filed February 14, 1991, now abandoned.

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***DECISION ON APPEAL***

This is an appeal from the final rejection of claims 118 to 128, 130 to 149, 151 and 152. These are the only claims remaining in the application.

The claimed invention is directed to a package for containing a pesticide or other potentially toxic chemical. The package consist of an outer container and inner container formed of water soluble flexible material. The free space and the humidity in the outer container are controlled to maintain the water soluble flexible inner container intact.

Claim 118 reproduced below is further illustrative of the claimed subject matter:

118. A package for a liquid comprising an outer container and a sealed water-soluble or water-dispersible envelope having a flexible wall, the sealed envelope containing a pesticide which is potentially toxic or damaging or detrimental to health or to the environment, the outer container having a lid and being sealed such that the outer container surrounds and encloses the sealed envelope and there is a space between the outer container and the sealed envelope, the space being at least 5% of a volume of the container and the space being isolated from the atmosphere by the sealed outer container, the relative humidity in the space being from 45 to 65% at a temperature of 20°C.

The references of record relied upon by the examiner as evidence of obviousness are:

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CUILLE 1962	3,030,266	Apr. 17,
WINGARDH 1973	3,717,274	Feb. 20,
SONDEL 1973	3,739,827	Jun. 19,
MCCLINTON 27, 1981	4,296,859	Oct.
WHITE (Great Britain)	708,813	May 12, 1954
PHILLIPS (Great Britain) 1963	922,317	Mar. 27,

#### ***REJECTIONS***

Claim 118 through 128 and 130 through 149 stand rejected under 35 U.S.C. §103 as unpatentable over Phillips in view of any of Wingardh, McClinton, White or Sondel. According to the examiner, Phillips discloses a water soluble envelope having a flexible wall and containing a pesticide. The examiner is further of the view that the secondary references disclose disposing an envelope within an outer container and leaving a space between the outer container and the envelope. The examiner is also of the view that the recited relative humidity within the sealed outer container falls within the ambient range of relative humidity and would occur inherently in a closed, sealed container that was prepared under ambient conditions.

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Claims 151 and 152 stand rejected under 35 U.S.C. § 103 as unpatentable over Phillips in view of the secondary references to Wingardh, McClinton, White or Sondel and further in view of Cuille. According to the examiner, Cuille discloses adding viscosity thickeners to a pesticide. Consequently, the examiner has determined that to employ such alternative pesticide in the general prior art combination package would have been obvious to one of ordinary skill in the art.

#### **OPINION**

We have carefully reviewed the rejections on appeal in light of the arguments of the appellants and the examiner. As a result of this review we have determined that the applied prior art does not established a ***prima facie*** case of obviousness with respect to the claims on appeal. Accordingly, the rejections on appeal are reversed. Our reasons follow.

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We are in agreement with the examiner's finding that Phillips shows a water soluble envelope containing pesticide in an outer container. We are also in agreement with the examiner's finding that the four secondary references disclose flexible envelopes in outer containers. However, we disagree with the examiner's finding that the space between the outer containers and the envelopes of all the secondary references is at least 5% of the volume of the container. While we acknowledge that McClinton appears to show a space of greater than 5%, we must emphasize that there is no express disclosure of this feature in any of the secondary references. We must conclude that this finding of the examiner is based on speculation in viewing the various figures of the secondary references. Of course, the examiner may not resort to speculation and unfounded assumptions to supply deficiencies in the factual basis of the rejection under 35 U.S.C. § 103. ***In re GPAC Inc.***, 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995).

Moreover, even if the McClinton disclosure could be taken as providing some basis for the examiner's conclusion that a free space of at least 5% in the outer container would have

been ***prima facie*** obvious, the applied prior art provides no evidentiary basis for a conclusion that appellants' claimed humidity range was ***prima facie*** obvious at the time the invention was made. The examiner's assertion that the claimed humidity range in the outer container falls within the ambient humidity range of normal atmospheric humidity and would occur inherently in a container closed under such an atmosphere is suspect for two reasons.

First, closure of the package under ambient conditions would not necessarily result in a package with the attributes claimed by appellants. In actuality, the range of normal atmospheric humidity is much greater than that claimed by appellants. This is significant, inasmuch as the case law requires an inevitability or necessity for the establishment of an inherency. *See, for example, In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).

Secondly, there is no reasonable basis for the examiner to assume that any package such as the prior art package of Phillips was, indeed closed under ambient conditions. For example, it might be just as likely that a prior art package

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containing a chemical in an envelope susceptible to dissolution in water would have been closed not in an ambient atmosphere but in an atmosphere purged of all water. These assumptions on the part of the examiner, are significant, for as noted above, an examiner may not resort to unfounded assumptions and speculation in support of a rejection under section 103.

The reference disclosure of Cuille does not provide a teaching that would cure the lack of a factual basis in the disclosure of the references cited against claims 118 through 128 and 130 through 149. For this reason the rejection of claims 151 and 152 is also reversed.



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For these reasons, the examiner has not established a ***prima facie*** case of obviousness with respect of the claimed subject matter on appeal. Accordingly, the rejections on appeal are reversed.

***REVERSED***

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
WILLIAM F. PATE III	)	
Administrative Patent Judge	)	

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APJ ***PATE***

APJ FRANKFORT

APJ CALVERT

DECISION: ***REVERSED***

Send Reference(s): Yes No  
or Translation (s)

Panel Change: Yes No

Index Sheet-2901 Rejection(s): **103**

Prepared: August 7, 2000

Draft      Final

3 MEM. CONF. Y      N

OB/HD      GAU: **3208**

PALM / ACTS 2 / BOOK

DISK (FOIA) / REPORT